

## **REMARKS**

The non-final Office Action of November 24, 2003 has been fully considered by the Applicants. ~~Withdrawal of the rejections and issuance of a Notice of Allowance is requested.~~

Applicants note that the specification has been amended to more clearly reflect the size of the insert disks and components thereof. Specifically, as amended, the specification indicates that the diameter of the circular opening may be from about 1 cm to about 10,000 cm and the diameter of the disk may be from about 10 cm to about 1,000 cm. Applicants submit that because these diameters were set forth in original claims 6 and 7 respectively, they do not constitute new matter. Applicants request that the Examiner enter this amendment to the specification.

The Examiner noted that claims 19-21 were canceled in Amendment C, Paper No. 9 filed on June 11, 2002. The Examiner indicated that as the claims were previously canceled they cannot be reinstated with the same claim numbers. The Examiner suggested that if the Applicants intended to reinstate the claims that the claims should be presented with claim numbers higher than 24. Applicants note that claims 24-26 correspond to original claims 19-21 respectively. Applicants further note that claims 24-26 are dependent from or ultimately dependent from claim 16 which the Examiner has indicated is allowable. Applicants submit that claims 24-26 are therefore also allowable.

Claims 1-9 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants note that claim 1 has been canceled and therefore the rejection of that claim is moot. Applicants traverse the rejection of claims 2-9.

With respect to claim 2, the Examiner noted that claim 2 recites the thickness of the disk being "greater" and "lesser" at certain points therealong. The Examiner apparently did not understand what the respective thickness is for a greater than or lesser than. With respect to claim 3, the Examiner stated that there was insufficient antecedent basis for the limitation of the concentric circular opening in line 1 and indicated that there were two circular openings. With respect to claim 4, which recites that the diameter is non-adjustable, the Examiner stated "nothing is non-

adjustable.” Applicants note that while the Examiner rejected claims 1-9 under 35 U.S.C. §112, second paragraph, the Examiner does not specifically address any perceived problems with claims 5-9.

~~Applicants submit that as amended, claims 2-9 are definite and distinctly~~ and particularly point out the subject matter which the Applicants regard as their invention. Applicants note that the amendments have not been made for reasons of patentability but rather to provide clarification as to their meaning. Claim 2 is amended to clarify that the thickness of the disk adjacent to the particle outlet is greater than the thickness of the disk adjacent to the periphery of the disk. Claim 3 has been clarified to indicate that the concentric circular opening is the circular opening of the disk. While the Examiner did not address the circular opening in claims 4-6 and 23, claims 4-6 and 23 have also been clarified to indicate that the circular opening is the circular opening of the disk. Claim 4 has been clarified to indicate that the diameter of the circular opening is of a fixed distance. Withdrawal of the rejections of claims 2-9 is requested.

Claims 22 and 23 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,367,906 to Wall, et al. Applicants traverse.

According to the Examiner, Wall teaches a classifier wheel and a disk and a fastener to attach the disk to a particle outlet opening of the classifier wheel. The Examiner also stated that the classifier wheel further comprises an upper surface and a lower surface defining a first concentric circular opening therein and a plurality of blade veins connecting the upper surface to the lower surface.

Applicants submit that Wall does not anticipate claim 22. Applicants note that claim 22 has been clarified to indicate that the disk is fixed to the lower surface of the classifier wheel to define a second concentric circular opening within the first concentric circular opening and reduces the diameter of the first concentric circular opening. The Examiner has, in fact, already acknowledged that an apparatus with such a feature is patentable and not anticipated. Specifically, the Examiner stated that none of the references teach a classifier wheel that has upper and lower surfaces connected by veins “wherein there is a hole in the lower surface that has within it and fastened to it a disk with another circular hole in it.” (Office Action, February 25, 2003, page 7) (emphasis added). The Examiner has failed to show where the ‘906 reference teaches such a feature. Applicants request that the rejection of claim 22 be withdrawn.

Applicants submit that claim 23 is not anticipated by the '906 reference to Wall, et al. The Examiner stated that Wall comprises a centrifugal value for adjusting the diameter of the opening because the diameter of the opening is naturally chosen by the desired flow rate and particle size passage rate which are affected by the centrifugal action of the rotor. First, Applicants submit that claim 23 is not anticipated by the '906 reference because claim 23 is dependent from claim 22 which, as previously described herein, is not anticipated by the '906 reference. Therefore, since claim 22 is allowable over the '906 reference, claim 23 which is dependent therefrom is also allowable and not anticipated by the '906 reference.

Second, Applicants submit that the '906 reference completely fails to show a feature of a centrifugal value for adjusting the diameter of the circular opening of the disk as set forth in claim 23. The Examiner attempts to argue that the opening is inherently adjusted during the operation of the apparatus based on the centrifugal action of the rotor. This is clearly not the case because, optionally, an operator may choose to use a disk wherein the diameter of the circular opening is a fixed distance. In such a case, the diameter of the opening remains the same regardless of the centrifugal action of the rotor. The Examiner has not indicated or pointed to a specific showing in the '906 reference of a centrifugal value for adjusting the diameter of the circular opening of the disk. For at least these reasons the '906 reference fails to anticipate claim 23. Applicants request withdrawal of the rejection of claim 23.

Applicant's note that claims 2-9 have been clarified to reflect that they are dependent from or ultimately dependent from independent claim 22. As previously described herein, Applicants submit that claim 22 is allowable. Applicants submit that claims 2-9 are therefore also allowable.

Applicants note that claims 10-18 are allowed.

In view of the foregoing clarifications and remarks, the Applicants submit that the application and claims are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0037.



In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Richard M. Klein, at Telephone Number 216/861-5582, Cleveland, Ohio.

Respectfully submitted,

**FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP**

Richard M. Klein, Reg. No. 33,000  
1100 Superior Avenue, 7<sup>th</sup> Floor  
Cleveland, OH 44114-2518  
216/861-5582

**RECEIVED**  
MAR - 1 2004  
**GROUP 3600**